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09/954,807	09/12/2001	Irwin Jerold Singer	17037B	8210

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KIMBERLY-CLARK WORLDWIDE, INC.  
401 NORTH LAKE STREET  
NEENAH, WI 54956

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

10

DATE MAILED: 06/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/954,807

Applicant(s)

SINGER ET AL.

Examiner

Walter B Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11,13-31 is/are pending in the application.
- 4a) Of the above claim(s) 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-26 and 28-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-26 and 28 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that "the inventions of Group I and Group II are so closely related that a full and fair consideration of the Group I would necessarily include consideration of the method of Group II" (page 3, Paper #7). This is not found persuasive because these inventions are distinct for the reasons given in Paper #6 and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Applicants argue that they "are not claiming a nonwoven web per se, but are claiming a material which protects a sensitive surface of an article having a sensitive surface" (page 4, Paper #7); this argument is irrelevant because the claimed sensitive surface protective material can be used in a materially different process such as filtering particles from an air stream as made of record in paragraph 2 of Paper #6. Applicants argue that the storage sleeve claimed in claims 13-26 and the stack of articles claimed in claim 28 can not be used to filter air in an air stream; the material claimed in claims 1-11, however, can be used to filter air in an air stream and claims 13-26 and 28 are grouped in the same group of claims as claims 1-11.

The requirement is still deemed proper and is therefore made FINAL.

### ***Information Disclosure Statement***

2. Copies of the signed PTO-1449 forms for the IDSs filed December 10, 2001 and September 25, 2002 have been included with this Office Action as requested by Applicant on pages 9-10 of Paper #7.

***WITHDRAWN REJECTIONS***

3. The 35 U.S.C. 112, second paragraph rejection of claims 2, 16, 20, 23 and 24 made of record in paragraph 8 of Paper #6 has been withdrawn due to Applicant's amendments in Paper #7.
4. The 35 U.S.C. 112, second paragraph rejection of claim 12 made of record in paragraph 8 of Paper #6 has been withdrawn due to Applicant's cancellation of claim 12 in Paper #7.
5. The 35 U.S.C. 112, second paragraph rejection of claim 28 made of record in paragraph 8 of Paper #6 has been withdrawn due to the fact that a 35 U.S.C. 112, second paragraph rejection was not intended to be made.
6. The 35 U.S.C. 103(a) rejection of claims 1-8 and 11-12 over Stokes et al. in view of Tsai et al. made of record in paragraph 10 of Paper #6 has been withdrawn due to Applicant's arguments in Paper #7.
7. The 35 U.S.C. 103(a) rejection of claims 9 and 10 over Stokes et al. in view of Tsai et al. and in further view of Midkiff made of record in paragraph 11 of Paper #6 has been withdrawn due to the new 35 U.S.C. 102(b) rejection of claims 9 and 10 as anticipated by Midkiff made of record in this Office Action (Paper #10).
8. The 35 U.S.C. 103(a) rejection of claims 13-26 over Stokes et al. in view of Tsai et al. and in further view of Drew made of record in paragraph 12 of Paper #6 has been withdrawn due to Applicant's arguments in Paper #7.
9. The 35 U.S.C. 103(a) rejection of claim 28 over Stokes et al. in view of Tsai et al. and in further view of Applicant's admission of prior art (i.e. Applicant's admitted prior art) made of

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record in paragraph 13 of Paper #6 has been withdrawn due to the new 35 U.S.C. 102(b) rejection of claim 1 as anticipated by Midkiff made of record in this Office Action (Paper #10).

***REPEATED REJECTIONS***

10. The 35 U.S.C. 112, second paragraph rejection of claims 1 and 13 made of record in paragraph 8 of Paper #6 has been repeated. Applicants argue that “the Examiner provides no reasoning why this language is found to be indefinite” (page 4, Paper #7); this is not true. The rejection to these claims made in Paper #6 reads: “In regard to claims 1 and 13, the structure intended to be recited by the limitation “a pattern having continuous bonded areas defining a plurality of discrete unbonded areas” is indefinite.” The “reasoning why this language is found to be indefinite” is that “the structure intended to be recited [by the cited limitation] is indefinite”. To clarify, the structure intended to be recited by the term “continuous” in the phrase “continuous bonded areas” cannot be ascertained. The bonded areas are “continuous” as opposed to what? What is “continuous” intended to mean with regard to the structure of the web?

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 112***

11. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The structure intended to be recited by the term “continuous” in the phrase “continuous bonded areas” cannot be ascertained. The bonded areas are “continuous” as opposed to what? What is “continuous” intended to mean with regard to the structure of the web?

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Midkiff.

In regard to claim 1, Midkiff teaches a spunbond nonwoven web comprising thermoplastic fibers useful as a protective web or as a component of diapers or feminine hygiene products (col. 1, lines 4-22 and col. 2, lines 30-55); therefore, Midkiff teaches that the spunbond nonwoven web is a sensitive surface protective material for protecting a sensitive surface of an article. Any protective web is a protective material that protects a surface of an article that is sensitive to something. Midkiff teaches that the web has bonds at almost every fiber crossover point (col. 7, lines 55-57); therefore, Midkiff teaches that the nonwoven web is bonded with a pattern having continuous bonded areas defining a plurality of discrete unbonded areas. Midkiff teaches that the web is electret treated so that particles are electrostaticly drawn toward the web (col. 8, lines 5-32). Since Midkiff teaches that particles are electrostaticly drawn toward the web, the sensitive surface protective material taught by Midkiff protects a sensitive surface from damage caused by particles by attracting the particles to the electret treated spunbond nonwoven web, and therefore, away from the sensitive surface. The phrase “for protecting a sensitive surface of an article” is an intended use phrase that has been given little patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the

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claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). The second recitation of “sensitive surface” in the claim 1 (fifth line) has also been given little patentable weight since the recitation “the sensitive surface” (fifth line of claim 1) refers to the “sensitive surface” recited in the intended use phrase.

In regard to claims 2-8, Midkiff teaches that the thermoplastic fibers comprise monocomponent fibers, multicomponent fibers or bicomponent fibers comprising a first polymer component and a second polymer component (the term “filament” as claimed is equivalent to the term “fiber” as Midkiff uses in the passages cited in this sentence), and that polypropylene and polyethylene are particularly suitable polymers used to make the fiber components (col. 3, lines 39-57 and col. 6, lines 56-60). Midkiff teaches that the polymeric components are configured in a side-by-side arrangement or a sheath/core arrangement wherein one polymer component is surrounded by another (and therefore wherein the sheath comprises the first polymer component and the core comprises the second polymer component as claimed in claim 8) (col. 3, lines 47-51).

In regard to claims 9 and 10, Midkiff teaches that the Gurley stiffness of the nonwoven web is at least 20mg (col. 2, lines 7-12), a range that overlaps with the ranges of less than about 80mg and about 15mg to about 75mg claimed in claims 9 and 10.

In regard to claim 11, Midkiff teaches that the nonwoven web is charged to about 1 kVDC/cm to 12 kVDC/cm (col. 8, lines 25-28), a range that overlaps with the claimed range of about 1 kVDC/cm to about 20 kVDC/cm.

***Claim Rejections - 35 USC § 103***

14. Claims 13-26 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midkiff in view of Drew.

Midkiff teaches the electret treated spunbond nonwoven web as discussed above.

In regard to claim 13, Midkiff fails to teach a storage sleeve for holding an article having a sensitive surface to protect the sensitive surface from damage comprising a first web and a second web comprising the electret treated spunbond nonwoven web of Midkiff interconnected with the first web to form a pocket to hold the article having a sensitive surface.

Drew, however, in regard to claims 13 and 16, discloses a storage sleeve comprising a first sheet (item 16) and a third sheet (item 14) and a spunbonded nonwoven polypropylene-fiber protective second sheet (item 18) positioned between the first and third sheets, where the first, second and third sheets are interconnected together at least on the bottom edge and two side edges to form a first pocket between the first and second sheets and to form a second pocket between the third and second sheets wherein compact discs (an article having a sensitive surface as claimed) are placed and the playing sides (the sensitive surface of the article having a sensitive surface as claimed) of the compact disks are in contact with the protective nonwoven sheet so that the playing surface of the compact disk is protected (col. 1, lines 41-54 and 63-65, col. 2, lines 6-13 and 39-43, col. 3, lines 42-66 and Figures 1-12; col. 5, lines 15-39). One of ordinary skill in the art would have recognized to have replaced the protective spunbonded nonwoven sheet of Drew with the electret treated spunbond nonwoven protective web of Midkiff so that the protective second sheet of the storage sleeve of Drew electrostatically attracts particles as taught



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by Midkiff in order to enhance the protective capability of the protective second sheet of the storage sleeve of Drew.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the protective spunbonded nonwoven sheet of Drew with the electret treated spunbond nonwoven protective web of Midkiff so that the protective second sheet of the storage sleeve of Drew electrostaticly attracts particles as taught by Midkiff in order to enhance the protective capability of the protective second sheet of the storage sleeve of Drew.

In regard to claims 14-15 and 17-18, Drew disclose that the first and third sheets are made of polypropylene (col. 3, lines 57-62); the first and third sheets are therefore polypropylene films.

The limitations of claims 19-22 and 24-26, which are directed entirely to the electret treated spunbond nonwoven web, were addressed in the rejection of claims 2-11 provided in this Office Action (Paper #10).

In regard to claim 23, which, when considered with claim 21 upon which claim 23 depends, claims that the sheath comprises polyethylene and that the core comprises polypropylene, Midkiff teaches that the thermoplastic fibers comprise bicomponent fibers comprising a first polymer component and a second polymer component (the term "filament" as claimed is equivalent to the term "fiber" as Midkiff uses in the passages cited in this sentence), that polypropylene and polyethylene are particularly suitable polymers used to make the fiber components (col. 3, lines 39-57 and col. 6, lines 56-60) and that the polymeric components are configured in a sheath/core arrangement wherein one polymer component is surrounded by another (col. 3, lines 47-51). Since the arrangement of the polyethylene and polypropylene

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components in the sheath/core arrangement is not limited by the disclosure of Midkiff, the arrangement where the sheath comprises polyethylene and the core comprises polypropylene is included in the disclosure of Midkiff and is therefore taught by Midkiff.

In regard to claims 29 and 30, Midkiff and Drew teach the storage sleeve as discussed above. Since Drew teaches that compact discs are placed in the first pocket between the first and second sheets and the second pocket between the third and second sheets and that the playing sides of the compact disks are in contact with the protective nonwoven sheet so that the playing surface of the compact disk is protected as discussed above in the rejection to claim 13, Drew teaches that the storage sleeve is capable of holding and protecting an article having a sensitive surface as claimed, where a compact disk corresponds to the article as claimed and the playing surface of the compact disk is the sensitive surface of the article as claimed. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Furthermore, since Midkiff teaches that the web is electret treated so that particles are electrostaticly drawn toward the web (col. 8, lines 5-32), the sensitive surface protective material taught by Midkiff protects the sensitive surface from damage caused by particles as claimed by attracting the particles to the electret treated spunbond nonwoven web, and therefore, away from the sensitive surface. Furthermore, Drew teaches that the storage sleeve has an open end to allow the article having the sensitive surface to be inserted into the storage sleeve as claimed and that the storage sleeve has a shape to accommodate the article having a sensitive surface as claimed (see all Figures). In regard to claim 30, Drew teaches an article having a sensitive surface protected by the storage sleeve as discussed in the rejections to claims

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13 and 29 and that the article is located inside the storage sleeve as claimed (see, for example, Figure 1A, where item 4, the compact disk, is located inside the storage sleeve, and col. 3, lines 43-47).

In regard to claim 31, Midkiff teaches the sensitive surface protective material as discussed above. Midkiff fails to explicitly teach an article having a sensitive surface protected by the sensitive surface protective material where the sensitive surface of the article is in contact with the sensitive surface protective material. Drew, however, discloses a pocket wherein a compact disc (an article having a sensitive surface as claimed) is placed and the playing side (the sensitive surface of the article having a sensitive surface as claimed) of the compact disk is in contact with a protective nonwoven sheet so that the playing surface of the compact disk is protected (col. 1, lines 41-54 and 63-65, col. 2, lines 6-13 and 39-43, col. 3, lines 42-66 and Figures 1-12; col. 5, lines 15-39). Therefore, one of ordinary skill in the art would have recognized to have used the protective web of Midkiff et al. as the protective nonwoven sheet of Drew et al. since it is notoriously well known to protect a sensitive surface of an article by placing the sensitive surface of the article in contact with a sensitive surface protective material as taught by Drew.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the protective web of Midkiff et al. as the protective nonwoven sheet of Drew et al. since it is notoriously well known to protect a sensitive surface of an article by placing the sensitive surface of the article in contact with a sensitive surface protective material as taught by Drew.

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15. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Midkiff in view of the admitted prior art of Applicant (page 1, line 25-page 2, line 1).

Midkiff teaches the electret treated spunbond nonwoven protective web as discussed above. Midkiff fails to teach a stack of articles having a sensitive surface comprising the sensitive surface protecting material of Midkiff between each article in the stack. However, Applicants disclose that photographic transparencies are protected by inserting a sheet of paper between each transparency and that the sheets of paper between each transparency in a stack of transparencies protect the transparencies from dust build-up during storage (page 1, line 25-page 2, line 1). One of ordinary skill in the art would have recognized to have used the electret treated spunbond nonwoven protective web of Midkiff in place of the sheets of paper used to protect each photographic transparency in a stack of photographic transparencies as disclosed by Applicants in order to protect the photographic transparencies from dust build-up during storage to a greater degree than is possible with paper due to the fact that particles (i.e. dust) are electrostatically attracted to the electret treated spunbond nonwoven protective web of Midkiff as taught by Midkiff.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the electret treated spunbond nonwoven protective web of Midkiff in place of the sheets of paper used to protect each photographic transparency in a stack of photographic transparencies as disclosed by Applicants in order to protect the photographic transparencies from dust build-up during storage to a greater degree than is possible with paper due to the fact that particles (i.e. dust) are electrostatically attracted to the electret treated spunbond nonwoven protective web of Midkiff as taught by Midkiff.

***ANSWERS TO APPLICANT'S ARGUMENTS***

16. Applicant's arguments on pages 6-8 of Paper #7 regarding the 35 U.S.C. 103(a) rejection of claims 1-8 and 11-12 over Stokes et al. in view of Tsai et al. made of record in paragraph 10 of Paper #6 are rendered moot due to the new 35 U.S.C. 102(b) rejection of claims 1-11 as anticipated by Midkiff made of record in this Office Action (Paper #10).

17. Applicant's arguments on page 8 of Paper #7 regarding the 35 U.S.C. 103(a) rejection of claims 9 and 10 over Stokes et al. in view of Tsai et al. and in further view of Midkiff made of record in paragraph 11 of Paper #6 are rendered moot due to the new 35 U.S.C. 102(b) rejection of claims 1-11 as anticipated by Midkiff made of record in this Office Action (Paper #10).

18. Applicant's arguments on pages 8-9 of Paper #7 regarding the 35 U.S.C. 103(a) rejection of claims 13-26 over Stokes et al. in view of Tsai et al. and in further view of Drew made of record in paragraph 12 of Paper #6 are rendered moot due to the new 35 U.S.C. 103(a) rejection of claims 13-26 over Midkiff in view of Drew made of record in this Office Action (Paper #10).

19. Applicant's arguments on page 9 of Paper #7 regarding the 35 U.S.C. 103(a) rejection of claim 28 over Stokes et al. in view of Tsai et al. and in further view of Applicant's admission of prior art made of record in paragraph 13 of Paper #6 are rendered moot due to the new 35 U.S.C. 103(a) rejection of claim 28 over Midkiff in view of Applicant's admitted prior art made of record in this Office Action (Paper #10).

However, in response to Applicant's argument regarding the admitted prior art, the admitted prior art clearly teaches that it is beyond notoriously well known to use a sheet of material to protect each photographic transparency in a stack of photographic transparencies in order to protect the photographic transparencies from dust build-up (dust corresponds to particles

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as claimed) during storage (page 1, line 25-page 2, line 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the electret treated spunbond nonwoven protective web of Midkiff in place of the sheets of paper used to protect each photographic transparency in a stack of photographic transparencies as disclosed by Applicants in order to protect the photographic transparencies from dust build-up during storage to a greater degree than is possible with paper due to the fact that particles (i.e. dust) are electrostatically attracted to the electret treated spunbond nonwoven protective web of Midkiff as taught by Midkiff, as made of record in this Office Action (Paper #10).

### *Conclusion*


20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba  
05/22/03

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

5/30/03